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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,631	10/27/2003	Kevin L. Corcoran	021919-001110US	6410

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EXAMINER

BLAKE, CAROLYN T

ART UNIT PAPER NUMBER

3724

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/695,631

Applicant(s)

CORCORAN ET AL.

Examiner

Carolyn T. Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 12, 13 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 13 and 21-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on July 5, 2005.
2. The objection to the drawings is withdrawn in view of the amendment.
3. The objection to the specification is withdrawn in view of the amendment.
4. The rejection of claim 11 under 35 USC 112 is withdrawn in view of the amendment.
5. The text of those sections in Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.84(h)(5) because Figure 1 show(s) modified forms of construction in the same view. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

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the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

7. Claims 1, 2, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nehr (799,928).

Regarding claim 1, Nehr discloses a punch comprising: a cutting component (B) that is configured to a shape; a cutting component housing (A) that houses the cutting component (B), the cutting component (B) extending beyond the cutting component housing (A); and a handle component (11) extending from the cutting component housing (A) for positioning the punch, and the handle component (11) configured to maintain an approximate orientation of the cutting component relative to the cutting medium.

Regarding claim 2, Nehr discloses the cutting component (B) is a die configured to a shape.

Regarding claim 12, the handle component (11) includes a grip.

Regarding claim 26, Nehr discloses the cutting component housing (A) is configured to allow a force to be applied directly to the cutting component (B).

Regarding claim 27, Nehr discloses the cutting component housing (A) is configured to allow a hammer to apply a cutting force to the cutting component (B).

8. Claims 1, 2, 25-27, 29, and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Russell et al (5,746,104).

Regarding claim 1, Russell et al discloses a punch comprising: a cutting component (25) that is configured to a shape; a cutting component housing (23, including fork of 29) that houses the cutting component (25), the cutting component (25) extending beyond the cutting component housing (23); and a handle component (29) extending from the cutting component housing (A) for positioning the punch, and the handle component (11) configured to maintain an approximate orientation of the cutting component (25) relative to the cutting medium.

Regarding claim 2, Russell et al disclose the cutting component (25) is a die configured to a shape.

Regarding claim 25, Russell et al disclose the cutting component housing (23) comprising a top surface (top surface in FIG 2) and a bottom surface (bottom surface in FIG 2), and wherein the cutting component (25) extends beyond the top surface and the bottom surface. The cutting component extends to the right in FIG 2, and thus it extends beyond the top and bottom surfaces.

Regarding claim 26, Russell et al disclose the cutting component housing (23) is configured to allow a force to be applied directly to the cutting component (25).

Regarding claim 27, Russell et al disclose the cutting component housing (23) is configured to allow a hammer to apply a cutting force to the cutting component (25).

Regarding claim 29, Russell et al disclose a punch assembly, comprising: a punch holding end (23, including fork of shank 29) having a top side (top surface in FIG 2) and opposing cutting side (bottom surface in FIG 2); a punch die (25) positioned in the punch holding end (23) and having a cutting edge that extends beyond the cutting

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side of the punch holding end (23); and a handle (29) extending from the punch holding end and configured, at least in part, to limit a cutting depth of the punch die (25).

Regarding claim 31, Russell et al disclose the punch die (25) extends beyond the top side of the punch holding end (23).

Regarding claim 32, Russell et al disclose a side of the punch die opposite the cutting edge is configured to directly receive a cutting force.

Regarding claim 33, Russell et al disclose the handle (29) is configured to substantially maintain an orientation of the cutting die (25) relative to the cutting medium.

9. Claims 21 and 29, 30, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Patenaude (5,230,156).

Regarding claim 21, Patenaude discloses a punch assembly, comprising: a handle end (15) and an opposite punch holding end (11); the punch holding end (11) holding a punch die (18) that extends beyond a cutting side of the punch holding end (11); and the handle end (15) includes a sleeve (unnumbered) with the thickness of the sleeve being approximately equal to one-half of the distance that the punch die (18) extends from the cutting side of the punch holding end (11). See FIG 4.

Regarding claim 29, Patenaude discloses a punch assembly, comprising: a punch holding end (11) having a top side (14) and opposing cutting side (13); a punch die (18) positioned in the punch holding end (11) and having a cutting edge that extends beyond the cutting side of the punch holding end (11); and a handle (15) extending from

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the punch holding end and configured, at least in part, to limit a cutting depth of the punch die (18).

Regarding claim 30, Patenaude discloses a sleeve (unnumbered) covering at least a portion of the handle (15), and at least a portion of the sleeve configured to cooperate with the handle to limit the depth of the punch die (18).

Regarding claim 32, Patenaude discloses a side of the punch die opposite the cutting edge is configured to directly receive a cutting force.

Regarding claim 33, Patenaude discloses the handle (15) is configured to substantially maintain an orientation of the cutting die (18) relative to the cutting medium.

10. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Chen (6,189,220). Chen discloses a punch assembly comprising: a cutting component (44) that is configured to a shape; a cutting component housing (A) (40) that houses the cutting component (44), the cutting component (40) extending beyond the cutting component housing (A); a handle component (34) extending from the cutting component housing (A) (40) for positioning the punch, and the handle component (34) configured to maintain an approximate orientation of the cutting component (40) relative to a cutting medium; and a cutting pad (64) adapted to be positioned so that the cutting pad (64) is adjacent the cutting component (44) when in use.

***Claim Rejections - 35 USC § 103***

11. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehr as applied to claim 2 above, and further in view of Smith (3,250,163). Nehr fails to

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disclose the material and method of manufacturing the die. However, Smith discloses a die made from steel rule (34), wherein the steel rule (34) has a first end and a second end; the first end and the second end are aligned and secured by welding. The ends of the steel rule (34) are welded to a plate (36). See col. 2, lines 48-50. Smith further discloses the advantages of using a steel rule die include low cost, high effectiveness, and longevity (col. 1, lines 12-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the die of the Nehr device from steel rule, as disclosed by Smith, because steel rule is inexpensive, effective, and long lasting.

12. Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehr as applied to claim 12 above, and further in view of Hellinger et al (4,388,743). Nehr discloses a handle/grip (11), but fails to disclose the grip comprises a material that absorbs shock. However, Hellinger et al disclose a tool wherein the tool handle component (15) includes a grip (23) that slides on the handle (15) and is manufactured from a material (rubber) that absorbs shock. This material choice makes the handle comfortable for the operator and resists slipping that could occur during use. In addition, this grip/sleeve would limit the depth of cut with the handle component because an operator would hold the sleeve-handle combination when using the device and creating a cut. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a grip that is inserted on the handle and is manufactured from a shock-absorbing material, as disclosed by Hellinger et al, on the Nehr device for the purpose of operator comfort and sliding resistance.



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13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patenaude as applied to claim 21 above, and further in view of Bourbeau (5,561,903). Patenaude fails to disclose indicia identifying the cutting side of the punch assembly. However, Bourbeau discloses a tool wherein the tool action is indicated by indicia (62). The indicia allow the operator to use the proper side of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide indicia, as disclosed by Bourbeau, on the Patenaude device for the purpose of indicating the action side of the tool.

14. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patenaude as applied to claim 21 above, and further in view of Smith (3,250,163). Patenaude fails to disclose the material and method of manufacturing the die. However, Smith discloses a die made from steel rule (34), wherein the steel rule (34) has a first end and a second end; the first end and the second end are aligned and secured by welding. The ends of the steel rule (34) are welded to a plate (36). See col. 2, lines 48-50. Smith further discloses the advantages of using a steel rule die include low cost, high effectiveness, and longevity (col. 1, lines 12-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the die of the Patenaude device from steel rule, as disclosed by Smith, because steel rule is inexpensive, effective, and long lasting.

### ***Response to Arguments***

15. Applicant's arguments with respect to the rejection(s) of claim(s) 21-23 under 35 USC § 103(a) have been fully considered and are persuasive. Therefore, the rejection

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has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Patenaude.

16. Applicant's arguments regarding the remaining claims have been fully considered but they are not persuasive.

Regarding the new claim limitation including "an approximate orientation of the cutting component," the Examiner fails to see how this limitation reads over the prior art of record. Any handle would allow an operator to orientate the device, including the cutting component, relative to the cutting medium, and thus "maintain an approximate orientation of the cutting component relative to a cutting medium."

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T. Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CB  
September 19, 2005



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